

Serial No.: 10/825,799

PATENT APPLICATION
Docket No.: NC 84,981

REMARKS

Claims 1-21 and 23-36 are pending in the application. Claims 1-20 and 27-36 have been withdrawn pursuant to a restriction/election of species requirements. Claim 22 has been cancelled by this amendment without prejudice.

Claim 21 has been amended to specify a Markush group for Ar¹. Support for this amendment is found in canceled claim 22.

Claim 21 is canceled to delete a proviso that is no longer within the scope of the claim.

Claim 21 is amended to add a proviso that when Ar² is phenyl, then either Ar¹, Ar², or both are m-phenyl. Support for this amendment is found in paragraph 0033.

Claim 25 is amended to delete two members of the Markush group.

Claim 26 is amended to incorporate one member of the Markush group for T into the structure and to delete the Markush group.

Claim 26 is amended to change H to either H or F. Support for this amendment is found in claim 25, before it was amended.

No new matter has been added.

Information Disclosure Statement

An IDS containing the entirety the references mentioned in the Chem Abstracts cited by the Examiner is attached.

Claim Rejections – 35 U.S.C. § 102

Claims 21 and 26 have been rejected under 35 U.S.C § 102(b) as allegedly anticipated by Chem Abstract 130:4439 or 120:108429.

Claim 21 recites certain cyanate esters having defined Ar¹ and Ar² groups. Ar¹ is a phenyl. Claim 26 recites similar cyanate esters of limited length and, in the terms of claim 21, having Ar¹ being benzophenone and Ar² being a bisphenol.

Chem Abstract 130:4439 discloses a cyanate ester where Ar¹ is diphenyl sulphone.

Chem Abstract 120:208429 discloses a cyanate ester where Ar¹ is a bisphenol.

In order to make a *prima facie* case of anticipation, the reference must disclose each limitation of the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053, 814 F.2d 628, 631 (Fed. Cir. 1987); MPEP 2131. Among other deficiencies, the

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references do not disclose the limitation in claim 21 Ar¹ is a phenyl group or the limitation in claim 26 that Ar¹ is benzophenone. As all the claim limitations have not been disclosed, a *prima facie* case of anticipation has not been made.

Claim Rejections – 35 U.S.C. § 103

Claims 21-26 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Srinivasan et al. (*High Perform. Polym.*), Chem Abstract 130:4439, 126:293637, 120:135811, 120:109005, 120:108429, 85:78980, or 79:54306.

Srinivasan discloses a cyanate ester where Ar¹ is benzophenone and Ar² is bisphenol. A high molecular weight of at least 14,100 was made (p. 264, Table 2, fifth line) corresponding to n of 34.

In order to make a *prima facie* case of obviousness, each claim limitation must be disclosed in the references (MPEP 2143.03). Among other deficiencies, the reference does not disclose the limitation in claim 21 that Ar¹ is phenyl. As to claim 26, the reference does not disclose the limitation that n is from 1 to 5. The reference uses the much larger n of 34.

Chem Abstract 130:4439 discloses a cyanate ester where Ar¹ is diphenyl sulphone.

Chem Abstract 126:293637 discloses a cyanate ester where Ar¹ is diphenyl sulphone.

Chem Abstract 120:135811 discloses a cyanate ester where Ar¹ is diphenyl sulphone.

Chem Abstract 120:109005 discloses a cyanate ester where Ar¹ is a bisphenol.

Chem Abstract 120:108429 discloses a cyanate ester where Ar¹ is a bisphenol.

Chem Abstract 85:78980 discloses a cyanate ester where Ar¹ is a methyl triazine diol.

Chem Abstract 79:54306 discloses a cyanate ester where Ar¹ is p-phenyl and Ar² is p-phenyl, Ar¹ is diphenyl ether and Ar² is p-phenyl, Ar¹ is diphenyl ether and Ar² is m-phenyl, Ar¹ is diphenyl sulphone and Ar² is p-phenyl, and Ar¹ is benzophenone and Ar² is p-phenyl.

Of all these structures, only two from 79:54306 disclose Ar¹ recited in the present claims. The first, Ar¹ is p-phenyl and Ar² is p-phenyl, discloses an Ar¹ from claim 21, but does not meet the proviso that when Ar² is phenyl, then either Ar¹, Ar², or both are m-phenyl. The second, Ar¹ is benzophenone and Ar² is p-phenyl, discloses Ar¹ from claim 26, but not that Ar² is a bisphenol.

As all the claim limitations are not disclosed in the reference, a *prima facie* case of obviousness has not been made.

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Claims 23-25 depend from and contain all the limitations of claim 21 and are asserted to distinguish from the references at least in the same manner as claim 21.

In view of the foregoing, it is submitted that the application is now in condition for allowance.

In the event that a fee is required, please charge the fee to Deposit Account No. 50-0281, and in the event that there is a credit due, please credit Deposit Account No. 50-0281.

Respectfully submitted,



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